

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURENCE J. BOOTON and CHARLES R. CARRINGTON

Appeal 2007-2434
Application 09/936,220
Technology Center 2600

Decided: September 5, 2007

Before: ALLEN R. MACDONALD, JAY P. LUCAS, and JOHN A. JEFFERY, *Administrative Patent Judges.*

MACDONALD, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-10. We have jurisdiction under 35 U.S.C. § 6(b). A hearing was held on August 7, 2007.

Appellants' invention relates to computer telephony integration (CTI) with calling line identification (CLI). (Amended Spec. 1). According to Appellants, the invention is:

A CTI system [which] includes a translation table of user names against consistent (i.e. simulated) calling line identity. When a user originates a call, the CTI server knows the name of the user currently associated with, i.e. logged on at, the originating work desk, and refers to the consistent CLI translation table to obtain the consistent CLI for that user, and to instruct the switch to make the call using that consistent CLI in the setup signalling [sic] message.

(Abstract).

Representative independent claim 1 under appeal reads as follows:

1. A method of operating a switching system to make a call, the method comprising:

responding to a request for the making of a call by obtaining an actual calling party identity;

translating the obtained actual calling party identity to obtain a corresponding simulated consistent calling line identity permanently associated with the calling party; and

sending a setup signalling [sic] message for establishing a call to the called party, the setup signalling [sic] message having a calling line identity field containing the obtained corresponding simulated consistent calling line identity, the simulated consistent calling line identity also enabling calls to be delivered to the party associated with the simulated CLI by use of translation tables which hold information as to the identity of that party and their current recorded location.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kahn	US 4,086,438	Apr. 25, 1978
Staples	US 5,889,845	Mar. 30, 1999
Gruchala	US 6,252,953 B1	Jun. 26, 2001

The Examiner rejected claims 1-5 and 7-10 under 35 U.S.C. § 103(a) as being unpatentable over Staples and Gruchala.

The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Staples, Gruchala, and Kahn.

Appellants contend that the claimed subject matter is not described by the prior art. More specifically, Appellants contend that:

1) Gruchala only teaches a simulated CLI for a group, not for an individual party (Br. 11), “it is simply not possible for the called party to use the received modified calling party CLI number as a means of contacting a particular calling party-as opposed to a collective group number” (Br. 13); and the inventions of claims 1 and 7 require “one-to-one correspondence between an ‘actual calling party identity’ and its translated ‘corresponding simulated consistent calling line identity permanently associated with the calling party’.” (Br. 13).

2) Claims 2 and 8 “concern activities that must be performed prior to call setup.” (Br. 14).

3) Regarding the rejection of claims 3 and 9:

[T]he Examiner appears to overlook the chronology in the applicant's claim and the chronology taught in the reference. Claim 3 concerns detecting the identity of a computer from which a request to make a call has been sent, the computer already being in communication with the CTI controller. Whereas the passages cited by the Examiner

concern initiating communication between a remote computer and the virtual presence server.

(Br. 14).

4) Regarding the rejection of claim 6:

The Examiner does not seem to understand that claim 6 is directed towards handling an incoming returned call to the CTI system.

(Br. 15).

In response to Appellants' contentions, the Examiner contends that:

1) As to claims 1 and 7, "Appellant [sic] is reading limitations into the claims." (Answer 10).

2) Claims 2 and 8 do not recite "prior to call setup" and instead are limited to "after the line goes off hook" (Answer 11).

3) As to claims 3 and 9:

Staples is intended for the purpose of connecting (logging in) a remote user to maintain a virtual presence. Thus, the identity of the computer (e.g., IP address, see cot. 20, lines 30-40 and col. 2, lines 55-60) is important to recognize the remote user.

(Answer 12).

4) As to claim 6:

[T]he Kahn reference was introduced to teach the feature of "clearing down that incoming call" and "making a call to the calling party based on the calling line identity" and "joining the call to the calling party... etc". Kahn teaches the feature of "call-back/local" (reads on the claimed "making a call to the calling party").

(Answer 13).

We affirm.

ISSUE(S)

A) Have Appellants shown that the Examiner has failed to establish the prior art describes all the limitations required by claims 1 and 7?

B) Have Appellants shown that the Examiner has failed to establish the prior art describes all the limitations required by claims 2 and 8?

C) Have Appellants shown that the Examiner has failed to establish the prior art describes all the limitations required by claims 3 and 9?

D) Have Appellants shown that the Examiner has failed to establish the prior art describes all the limitations required by claim 6?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Appellants' Invention

1. Appellants' invention relates to computer telephony integration (CTI) with calling line identification (CLI). (Amended Spec. 1).

2. According to Appellants, when a user originates a call, a CTI server knows the name of the user currently associated with, i.e. logged on at, an originating work desk, and refers to a consistent CLI translation table to obtain the consistent CLI for that user, and to instruct a switch to make the call using that consistent CLI in the setup signaling message. (Abstract).

3. Appellants state that:

Alternatively, the step of responding to a request for the making of a call by obtaining an actual calling party identity may comprise the substeps of retrieving from signalling information of an incoming call to the switching system a calling line identity, and translating the

retrieved calling line identity to obtain a corresponding actual calling party identity.

Preferably, there is included the step of joining the incoming call to the call to the called party.

(Amended Spec. 3:18-23).

4. Appellants further state that:

Alternatively, there may be included the steps of clearing down that incoming call, making a call to the calling party based on the calling line identity of that incoming call, and joining the call to the calling party to the call to the called party.

(Amended Spec. 3:24-27).

5. Appellants also state that:

It will be appreciated that a DNIS [Dialled Number Identification Service] need not correspond to an individual person, but may relate to a department or-group, or a specific function within a company.

(Amended Spec. 13:23-25).

Staples

6. Figure 3 of Staples shows phone 124 routed through PC 102A and Notebook Speakerphone (no icon) routed through Note Book 102B.

7. Staples states (Abstract):

First the remote user establishes a virtual presence connection at the corporate office, including providing identification and security information. Once the remote user is connected, the virtual presence server instructs the corporate PBX to automatically forward all calls to the remote user.

8. Staples also states (Abstract):

The virtual presence server also routes email, faxes, and LAN data to the remote user. The virtual presence server also extends the corporate PBX and corporate LAN features to the remote user, just as

if the remote user were physically located in the corporate office. According to the invention, the remote user makes outgoing telephone calls, sends faxes, transmits data, sends email and performs Internet access as if the remote user were physically present in the corporate office.

9. Staples also states (Abstract):

The virtual presence server and/or the user communication device also performs a call forwarding operation to call forward telephone calls made to the user's home to the virtual presence server at the corporate office. These calls are then routed through the virtual presence server to the user's home. Thus the user can receive home telephone calls while the user is connected to the corporate office, wherein the home telephone calls are received on the same telephone line which is being used for the virtual presence connection.

PRINCIPLES OF LAW

On appeal, Appellants bear the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of the prior art.

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*,

383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S. Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR* at 11 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

Under this framework, once an Examiner demonstrates that the elements are known in the prior art and that one of ordinary skill could combine the elements as claimed by known methods and would recognize that the capabilities or functions of the combination are predictable, then the Examiner has made a *prima facie* case that the claimed subject matter is likely to be obvious. The burden then shifts to Appellants to show that the Examiner erred in these findings or to provide other evidence to show that the claimed subject matter would have been nonobvious.

ANALYSIS

Claims 1 and 7

Appellants correctly point out the prior art fails to teach a one-to-one correspondence between actual CLI and simulated CLI. However we do not find that the argued limitation is required by the claim language. Appellants base their position on the premise that the intended use clause (“the simulated calling line identity also enabling . . .”) at the end of claims 1 and 7 limits the recited steps or structure to the argued one-to-one correspondence. We disagree.

The determination of whether an intended use clause is a limitation in a claim depends on the specific facts of the case. *In Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the

invention.” *Id.* However, the court noted (quoting *Minton v. Nat ’l Ass ’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”” *Id.*

In the situation before us, the intended us clause is directed to functions (reverse calling) that are also enabled, i.e., occur at some future time. The steps or structure for performing those future functions are not recited in the claims. We will not read the argued limitations into the claims. However, Appellants are not precluded from amending the claims to recite the argued limitations.

On the record before us, Appellants have not shown that the Examiner erred in rejecting Claims 1 and 7 under § 103(a).

Claims 2 and 8

Again we find that Appellants are arguing a limitation (“activities must be performed prior to call setup”) which is not found in the claims. As the Examiner correctly points out, the only temporal limitation in claims 2 and 8 is the requirement of a change to “off hook status” before detecting and translating. Appellants do not argue that the prior art lacks this “off hook” limitation.

On the record before us, Appellants have not shown that the Examiner erred in rejecting Claims 2 and 8 under § 103(a).

Claims 3 and 9

Appellants are again arguing a chronological limitation. Specifically, Appellants argue that the computer must first be logged on before the functions of the claims are performed. We agree.

However, Staples explicitly describes this feature (see Findings of Fact 7-8).

On the record before us, Appellants have not shown that the Examiner erred in rejecting Claims 3 and 9 under § 103(a).

Claim 6

Appellants argue “[t]he Examiner does not seem to understand that claim 6 is directed towards handling an incoming returned call to the CTI system.” We disagree.

Nothing in claim 6 limits it to a “returned” call as argued. Rather, claim 6 corresponds to Appellants’ alternative embodiment for the user to make calls through the switch (see Findings of Fact 3-4). This alternative is described in detail at page 12, line 11, through page 13, line 2 of Appellants’ Amended Specification.

On the record before us, Appellants have not shown that the Examiner erred in rejecting Claim 6 under § 103(a).

Summary

Contrary to Appellants’ arguments with respect to claims 1-10, we find no explicitly claimed step or structure that is directed to handling a

“returned” call. We again point out that Appellants are not precluded from amending the claims to recite such limitations.

CONCLUSION OF LAW

(1) Appellants have failed to establish that the Examiner erred in rejecting claims 1-5 and 7-10 as being unpatentable under 35 U.S.C. § 103(a) over Staples and Gruchala.

(2) Appellants have failed to establish that the Examiner erred in rejecting claim 6 as being unpatentable under 35 U.S.C. § 103(a) over Staples, Gruchala, and Kahn.

(3) Claims 1-10 are not patentable.

DECISION

The Examiner's rejection of claims 1-10 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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